

### REMARKS

Claims 1-2 and 5-16 are pending. In the Office Action, the Examiner rejects Claims 1-2 under 35 U.S.C. § 103(a) as being unpatentable over W.O. Pat. Pub. App. No. 97/45814 to Vazvan ("Vazvan") in view of U.S. Pat. Pub. App. No. 2001/0054087 to Flom et al. ("Flom") and further in view of U.S. Pat. No. 7,240,036 to Mamdani. Claims 5-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vazvan in view of U.S. Pat. No. 5,933,812 to Meyer et al. ("Meyer") and further in view of Mamdani.

Applicants have amended independent Claims 1, 5, and 12 to clarify the claimed invention. Several dependent claims have been amended so that they are consistent with the amended independent base claims. In light of the amendments and subsequent remarks, Applicants respectfully submit that the claims are in condition for allowance.

#### Examiner's Claim Construction in the Office Action

Initially, Applicants note that the Patent Office has the initial burden of proof in establishing *prima facie* anticipation or obviousness of a claimed invention under 35 U.S.C. § 102 or § 103. *In re Warner*, 379 F.3d 1011, 1016 (CCPA 1967). To make a fair review of the merits of a *prima facie* case of anticipation or obviousness, "[t]he Examiner must make specific findings as to claim construction." *Ex parte Beery*, Appeal No. 2008-0543, Application No. 09/954,823 (BPAI Sep. 29, 2008) (emphasis added); *Ex parte Blankenstein et al.*, Appeal No. 2007-2872, Application No. 10/116,312 (BPAI Aug. 26, 2008); and *see Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997); and MPEP §§ 706, 706.07. And as has been held by the Court of Appeals for the Federal Circuit, "[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." *Lindemann Maschinenfabrik v. American Hoist and Derrick Company*, 730 F.2d 1452, 1458 (Fed. Cir. 1984) (emphasis added); and *see Waldermar Link v. Osteonics Corp.*, 32 F3d. 556, 559 (Fed. Cir. 1994) (explaining that, during prosecution, "the patent Examiner acts as a fact-finder").

In the Office Action of December 11, 2009, the Office has failed to provide Applicants with a sufficient claim construction or interpretation of the cited references so as to enable the Applicants to make a fair review of the merits of the case of obviousness proffered by the Examiner, or to effectively reply. Other than quoting or paraphrasing Applicants' claim language with annotated citations to figures, or column and line numbers of the cited references, the Examiner provides no finding or other explanation regarding Applicants' claims, the cited references, or the application of the cited references to Applicants' claims. The Board of Patent Appeals has found that the mere citing of passages of the prior art is insufficient to meet the Examiner's "initial burden of pointing out where the applied prior art teaches or suggests Appellant's invention." *Ex parte Beery*, Appeal No. 2008-0543, page 5. As stated by the Board in *Ex parte Beery*, "The difficulty we have with the Examiner's position is its failure to specifically point out where in the cited passages there is found a teaching of each of the disputed claim limitations." *Id.*

Applicants therefore respectfully submit that the Examiner has failed to establish prima facie anticipation of the claimed invention. Should the Examiner continue to reject the claims as being unpatentable over the same or any other ground, Applicants respectfully request that the Examiner submit on the record specific findings as to the construction being applied to the claims, an explanation of the references being cited against the claims, and how those references disclose recited features of the claims.

#### Examiner's Failure to Address Applicants' Traversals and Arguments Submitted in Previous Response

Moreover, the Examiner has habitually failed to respond to the Applicants' submitted arguments in previous responses. In the present Office Action, the Examiner maintains the same references and same combinations thereof as were cited in the preceding Office Action, yet fails to address previously submitted arguments and traversals in the claim rejections and in the response to arguments section states only that "Applicant's arguments filed on 1/30/08 with respect to claims 1, 5-12 have been considered but are moot in view of the new ground(s) of rejection." However, the claims

remain rejected under the same combination of references as applied to the claims in the previous Office Action and the rejection includes no substantive explanation of the Examiner's position and does not address in particular the arguments submitted in the previous office action distinguishing the claims from the cited references. Further, as mentioned to the Examiner in a phone call on May 6, 2009, the Examiner has never responded to arguments twice previously submitted traversing dependent Claim 6 and has merely used the same rejection language in three consecutive Office Actions without so much as acknowledging Applicants' arguments. Applicants note that the Examiner is required to answer all material traversed:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given. (*Manual of Patent Examining Procedure* § 707.07(f), emphasis added)

Applicants accordingly respectfully request that if the Examiner is to continue to assert the same references and combinations thereof that in the future, the Examiner address each of the Applicants asserted arguments.

The Rejection of Claims 5 and 12 under § 103 is Overcome

Independent Claim 5 is directed to a method comprising using a mobile station configured for short range proximity signaling and two way messaging to provide a short range proximity signal to a proximity reader. The method further comprises presenting

the mobile station to the proximity reader. The method also comprises providing identification information to a payment system. The method additionally comprises receiving verification of identity information from the payment system at the mobile station. The verification of identity information includes indicia of a unique transaction confirmation code generated by the payment system. The unique transaction confirmation code links an electronic bill of a user of the mobile station to a payment account for the user. The method further comprises ordering a plurality of products and accumulating charges. The method also comprises receiving on a display of the mobile station the electronic bill for a total charge.

Independent Claim 12 is directed to an apparatus comprising a processor configured to cause the apparatus to provide a short range proximity signal to a proximity reader. The processor is further configured to cause the apparatus to provide identification information to a payment system. The processor is additionally configured to cause the apparatus to receive verification of identity information from the payment system. The verification of identity information includes indicia of a unique transaction confirmation code generated by the payment system. The unique transaction confirmation code links an electronic bill of a user to a payment account for the user. The processor is also configured to cause the apparatus to submit an order for a plurality of products to the payment system. The processor is further configured to cause the apparatus to receive the electronic bill for a total charge.

The Office Action continues to rely on the combination of Vazvan, Meyer, and Mamdani as disclosing Claims 5 and 12. With respect to the recitation that the verification of identity information includes indicia of a unique transaction confirmation code generated by the payment system, the Office Action admits that "Vazvan and Meyer do not explicitly disclose" the recitation. See, Pages 5 and 8 of the Office Action. The Office Action instead relies on Fig. 2, item 104b and Col. 3, lines 55-67 to Col. 4, line 25 of Mamdani. Mamdani teaches that first and second transaction barcodes are sent to the mobile device. Item 104b of Fig. 2 merely describes comparing a spoken transaction requester authentication code with an authentic voice print for authentication purposes. In this regard, the spoken transaction is communicated from a wireless communication

device to a box 104a and then compared to a known authentic voice print for an authorized user of the wireless communication device. Accordingly, the voice print and spoken transaction requester authentication code are not only not unique to a single transaction, but are also not generated by a payment system and then sent to a user's mobile station.

Applicants therefore respectfully submit that Mamdani does not teach or suggest receipt of a unique transaction confirmation code generated by the payment system. Even if the Examiner is to continue to hold that Mamdani teaches receipt of a unique transaction confirmation code generated by the payment system, Claims 5 and 12 additionally recite that the unique transaction confirmation code links an electronic bill of a user to a payment account for the user. See, e.g., paragraphs 152-153 of the present application. With respect to Claim 5, the Office Action submits that Fig. 2, item 104b and Col. 3, lines 55-67 to Col. 4, line 25 of Mamdani teach this recitation. With respect to Claim 12, the Office Action does not even address the recitation and as such fails to even assert a case that Claim 12 and its dependent claims are obvious.

In contrast to Claims 5 and 12, Mamdani does not teach or suggest that either the first or second transaction barcode links an electronic bill of a user to a payment account for the user. Further, with respect to item 104b of Fig. 2 of Mamdani that the Examiner points to, this comparison is performed for providing identification of a user to the system and validating the identity of the user. See, Fig. 2 and Col. 3, lines 55-67 to Col. 4, line 25 of Mamdani. The unique transaction confirmation code recited by Claims 5 and 12 is provided to the user by the system and is provided to the user following provision of identification information to the payment system. Accordingly, while perhaps the Examiner may broadly construe item 104b as a provision of identification information to a payment system, it cannot possibly be construed to teach or suggest receipt of a unique transaction confirmation code generated by the payment system, let alone receipt of a unique transaction confirmation code linking an electronic bill of a user to a payment account for the user.

As admitted by the Office Action, the other cited references do not even suggest a unique transaction confirmation code. Accordingly, none of the other cited references,

taken alone or in combination with Mamdani, teaches or remotely suggests receipt of a unique transaction confirmation code generated by the payment system that links an electronic bill of a user to a payment account for the user as recited by Claims 5 and 12. Applicants therefore respectfully submit that the rejection of Claims 5 and 12 is overcome and Claims 5 and 12 are in condition for allowance.

The Rejection of Claim 1 under § 103 is Overcome

Independent Claim 1 is generally directed to a system comprising a proximity reader configured to interact with a mobile station presented to the proximity reader by a user. The mobile station is configured for short range proximity signaling and two way messaging. The proximity reader is configured to use short range proximity signaling to trigger initiation of a mobile payment session. The system further comprises a plurality of servers configured to provide authentication of a user and to process payments. The plurality of servers are further configured to initiate a voice call to the mobile station, request an authentication code from a user of the mobile station, and receive an authentication code entered into the mobile station by the user using one or more function keys of the mobile station. The system additionally comprises a plurality of point of sale terminals configured to provide access to transaction information. The system also comprises a messaging system configured to provide mobile commerce messaging with the user. The mobile commerce messaging includes digital content of at least one of digital cash, coupons, advertisements, games, ring-tones, graphics, videos via messaging, or promotion of a plurality of different items to purchase.

In order to clarify the patentable distinctions between Claim 1 and the cited references, Applicants have amended Claim 1 to recite the authentication code is entered into the mobile station by the user using one or more function keys of the mobile station. Accordingly, the user keys the authentication code into the mobile station using one or more function keys, such as by using a keypad. Support for this amendment may be found, for example, in FIG. 2B and in paragraphs 65 and 148 of the published application.

According to the claimed invention, the plurality of servers may utilize an Integrated Voice Response (IVR) system or voice over internet protocol (VoIP) authentication to call a customer's mobile number and request an authentication code, such as a PIN, from the user. The plurality of servers may then receive an authentication code entered into the mobile device by the user using one or more function keys of the mobile station. See, e.g. Paragraph 148 of the present application.

The Office Action admits that Vazvan and Flom do not disclose "wherein the plurality of servers are configured to initiate a voice call to the mobile device, request an authentication code from a user of the mobile device, and receive an authentication code entered into the mobile device by the user, (Pages 3 and 4 of the Office Action)" and instead relies on Mamdani. Mamdani teaches comparing a user spoken transaction requestor authentication code with an authentic voice print of an authorized user of the communication device. See, e.g., Fig. 2 (104b) and Col. 3, line 65 – Col. 4, line 20 of Mamdani. In contrast, amended independent Claim 1 recites initiating a voice call, requesting an authentication code from a user of the mobile station, and receiving an authentication code entered into the mobile station by the user using one or more function keys of the mobile station, such as described above. Accordingly, Mamdani does not teach or suggest receiving an authentication code entered into the mobile station by the user using one or more function keys of the mobile station, as Mamdani instead teaches receiving a spoken transaction requestor authentication code. Further, none of the other cited references cure the defect of Mamdani. Applicants, therefore, respectfully submit that none of the cited references, taken alone or in combination, teaches or suggests independent Claim 1 and the rejection is overcome. Applicants further submit that Claim 1 is in condition for allowance.

#### The Rejection of the Dependent Claims is Overcome

The dependent claims include all of the recitations of a respective independent base claim and as such Applicants further submit that the dependent claims are patentably distinct from the cited references taken alone or in combination for at least the reasons argued above. Therefore, Applicants respectfully submit that the rejections of the

dependent claims are overcome and the dependent claims are in condition for allowance.

In addition, with respect to Claim 6, Applicants have twice previously traversed the rejection of dependent Claim 6. However, the Office Action again fails to address Applicants' arguments with respect to Claim 6 and includes the same rejection language as was included in the two preceding Office Actions. Accordingly, Applicants continue to respectfully traverse the position of the Office Action that Vazvan discloses receiving a plurality of messages offering additional items to purchase on a display of the mobile device, adding a plurality of additional charges to the electronic bill, and approving of the total charge plus the plurality of additional charges as recited by Claim 6. Claim 6 is thus directed to a method wherein a user of a mobile device is presented with items for purchase in addition to items which the user has already selected to purchase and additional presented items which the user elects to purchase result in adding additional charges to an accumulated total electronic bill. In contrast, Vazvan merely discloses the presentation and payment of a bill for a purchase that a user has already elected to make. As such, Applicants respectfully submit that Vazvan neither teaches nor suggests the presentation to a user of messages offering additional items to purchase and then adding additional charges to the electronic bill as recited by Claim 6.

Applicants further traverse the rejections of dependent Claims 13 and 15, which depend from Claim 5 and Claim 12, respectively, and recite that providing identification information to a payment system comprises providing a PIN code and one or more of a table number or seat number to the payment system. The Office Action posits that Figs. 5 and 6 and paragraphs 68-69 of Flom teach providing identification information comprising a PIN code and one or more of a table number or seat number to a payment system. However, Fig. 5 of Flom merely illustrates an embodiment of a call center system (Paragraph 25 of Flom) and does not teach or suggest providing identification information, let alone providing identification information comprising a PIN code and one or more of a table number or seat number. Fig. 6 of Flom merely illustrates a flowchart for describing the call center system and does not teach or suggest providing identification information, let alone providing identification information comprising a PIN code and one or more of a table number or seat number. Further, the cited portions



of Flom merely describe that a user may perform a location based search for restaurants near the user's location. The user's location is taught to be derived from recent geo-specific search requests or retrieved from GPS information (Paragraph 69 of Flom). Accordingly, Flom does not teach or suggest providing identification information comprising a PIN code and one or more of a table number or seat number to the payment system as recited by Claims 13 and 15. As none of the other cited references, taken alone or in combination, teach or suggest Claims 13 and 15, Applicants respectfully submit that the rejection of Claims 13 and 15 is overcome such that Claims 13 and 15 are in condition for allowance.

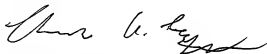
Applicants additionally traverse the rejections of dependent Claims 14 and 16, which depend from Claim 5 and Claim 12, respectively, and recite receiving email confirmation of transaction completion, the email including tagged data allowing the data to be used in other programs. See, e.g., paragraphs 156-157 of Applicants' published application. The Office Action posits that Figs. 2 and 5 and paragraph 34 of Flom teach Claims 14 and 16. However, Fig. 2 of Flom merely "illustrates an exemplary customized portable web site" (paragraph 21 of Flom) and does not teach or suggest receiving email confirmation of transaction completion, the email including tagged data allowing the data to be used in other programs. Fig. 5 of Flom merely "depicts and embodiment of a call center system" and likewise does not teach or suggest receiving email confirmation of transaction completion, the email including tagged data allowing the data to be used in other programs. Paragraph 34 merely states that the portable device may provide various application services, including "email interchange for accessing email messages" and may provide capabilities for "sending and receiving email." Accordingly, at most Flom teaches a device capable of sending and receiving email. Flom does not teach or suggest receiving email confirmation of transaction completion. Moreover, Flom does not teach or suggest that the received email confirmation includes tagged data allowing the data to be used in other programs. As none of the other cited references, taken alone or in combination, teach or suggest Claims 14 and 16, Applicants respectfully submit that the rejection of Claims 14 and 16 is overcome such that Claims 14 and 16 are in condition for allowance.

## CONCLUSION

In view of the amended claims and remarks presented above, it is respectfully submitted that all of the present claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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